UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/818,158	03/14/97	ANDREWS	RD996-141

EXAMINER	
G	

TM02/0925

SCOTT A. STINEBURNER
WOOD, HERRON & EVANS
2700 CREW TOWER
441 VINE STREET
CINCINNATI OH 45202-2917

ART UNIT	PAPER NUMBER
	21

DATE MAILED:
09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/818,158	Applicant(s) Andrews et al
	Examiner Thong Vu	Art Unit 2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 9, 2001*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *38-75* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *38-75* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

1. This office action is in response to Amendment D filed 1/20/1999. Claims 38-74 and new claim 75 are pending. The rejections cited are as stated below.

2. Claims 38-75 are rejected under 35 U.S.C. ° 103 as being unpatentable over Heath et al [Heath 6,006,034] in view of Martino [6,044,382]

3. As per claim 38, Heath discloses a apparatus, at least one processor, a memory, a computer program residing in the memory or an off line browser program, said computer program commencing to download a file referencing a plurality of components [Heath col 4 lines 28-48] However Heath fails to teach said computer program dynamically prompting a user to select which of said plurality of components to download. Martino discloses the executive menu then will be automatically presented to the user for selection of the desired menu, form, or process [Martino col 17 line 65-col 18 line 17] and the data stream download from database server and display in the menu/form [Martino col 19 lines 44-67]. .... . Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the server program automatically prompts a menu to user for select the download application as taught by Martino into the Heath's system to improve the data transaction between client/server in the network. Doing so would provide the user a chance to select the component on the download list of the components while enhance the communication process on network.

4. As per claims 50,61 and 62, contain the same limitations that were addressed in rejecting claim 38.

5. As per claim 39, Heath-Martino disclose the computer program as a Web browser application [Heath col 3 lines 20-37]

6. As per claim 40, Heath-Martino disclose said file as HTML document [Heath col 7 lines

60-65]

7. As per claim 41, Heath-Martino disclose the component download selection mechanism, said component download selection mechanism dynamically creating a component download selection list when said file with said plurality of components is download as an inherent feature of download list [Heath col 2 line 35-55]

8. As per claim 42, Heath-Martino disclose computer program comprises a web browser and wherein said component download selection list is formed in a second pane of said web browser and displayed with said file as a design choice of web browser [Heath col 3 lines 20-37]

9. As per claim 43, Heath-Martino disclose the component download selection list is formed in a dialog box as inherent feature of menu [Martino col 17 line 65-col 18 line 17]

10. As per claim 44-47, Heath-Martino disclose the component download list is inserted into said file and displayed; file name; type of components; size of each components as the inherent features of the download catalog list [Heath col 4 lines 28-48]

11. As per claim 48, Heath-Martino disclose component download selection list includes a status item, said status item dynamically displaying the amount of each of said plurality of page components that has been downloaded [Heath col 4 lines 28-48]

12. As per claim 49, Heath-Martino disclose status item includes the percentage of a page component downloaded as inherent feature of download list [Heath col 4 lines 28-48]

13. Claims 51-60 contain the same limitations that were addressed in rejecting claims 38-49 above. By the same rationale applied above, claims 50-60 are rejected.

14. As per claim 63, Heath-Martino disclose a recordable media or video cassette recorder as inherent feature of CD-ROM [Martino col 8 line 61-col 9 line 7]

15. As per claim 64, Heath-Martino disclose a transmission media as inherent feature of Internet [Heath abstract]

16. Claims 65-72 contain the same limitations that were addressed in rejecting claims 39-48 above. By the same rationale applied above, claims 65-72 are rejected.

17. Claims 73,74 contain the same limitations that were addressed in rejecting claims 38 and 39 above. By the same rationale applied above, claims 73-74 are rejected.

18. As per claim 75, Heath-Martino disclose the apparatus comprising at least one processor,; a memory coupled to at least one processor [Martino col 4 lines 22-37] and a computer program residing in the memory, said computer program commencing to download a file referencing a plurality of components [Heath col 4 lines 27-48], said computer program dynamically prompting a user to select which of said plurality of components to download [Martino col 4 lines 3- 65, col 8 lines 1-8, col 12 lines 1-13, col 19 lines 44-67, col 28 line 52-col 29 line 25], wherein the program is further configured to receive user input that selects at least one of the plurality of components, to commence to download at least one selected component from the plurality of component, and to display the file with the selected component embedded therein [Heath col 7 line 55-col 8 line 14]

Response to Arguments

19. Applicant's arguments filed 7/9/2001 have been fully considered but they are not persuasive to overcome the prior arts.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into

account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As per claims 1,50,61,73 and 74 applicant argues the prior art did not teach a computer program that dynamically prompts a user to select which of said plurality of components to download. Examiner notes the prior art taught application program on the client requests server to download a catalog of list of the application components, selectively identify and retrieve required components from server [Heath col 4 lines 27-48]. The prior art also taught the dynamically reconfigured for application by responding to prompt a setup template such as menu or form [Martino col 4 lines 3- 65, col 8 lines 1-8, col 12 lines 1-13, col 19 lines 44-67, col 28 line 52-col 29 line 25]. It is obvious a skilled artisan would modified the computer program to automatically display a list or menu to prompt user to select the component on the list or menu as a design choice.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Heath taught the client downloads a list of components from server. However Heath fails to detail how to display the list of components [Heath col 4 lines 27-48]. Martino

taught the data stream download from database server and display in the menu/form [Martino col 19 lines 44-67]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the server program automatically prompts a menu/ form to user for select the download application as taught by Martino into the Heath's system to improve the data transaction between client/server in the network.

Applicant argues the prior art taught the dynamically prompting a user to select application components alter the purpose and use of a catalog file and eliminate the version information in the catalog file. Examiner notes the claim language disclosed "computer program commencing to download a file referencing a plurality of components" [Heath col 4 lines 28-48] and "computer program dynamically prompting a user to select which of said plurality of components to download"[Martino col 17 line 65-col 18 line 17, col 19 lines 44-67].

Applicant argues the prior art taught the use of HTML document as contemplated by the invention. Examiner notes the prior art taught the Web browser, HTML document displayed on Web page [Heath Fig 7C, col 7 line 56-col 8 line 14]

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final	(703) 746-7238
Official:	(703) 746-7239
Non-Official	(703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu

Sept 18, 2001